



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,040	02/12/2002	Youichi Hanakawa	1553-017	3014
7590	04/21/2005	EXAMINER		
LOWE HAUPTMAN GILMAN & BERNER, LLP			DICUS, TAMRA	
1700 DIAGONAL ROAD		ART UNIT		PAPER NUMBER
SUITE 300		1774		
ALEXANDRIA, VA 22314		DATE MAILED: 04/21/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,040	HANAKAWA, YOICHI	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 7-13 and 15-27 is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

The RCE is acknowledged. The prior Office action rejection over claim 7 and the claims depending therefrom is withdrawn due to Applicant's amendments. Thus a new ground of rejection is presented below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7, 18, 22, 25-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner believes that independent claims 7, 18, 22, and 24 (amended), and 25-27 (new) do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on a sheet material free of weakened regions (claim 7), a sheet material defining a substantially constant thickness throughout sheet (claim 18), constant physical strength (claim 22), extension of material continuously without disruption or without tear or fold lines along which sheet can be torn or folded (claim 25), a true rectangle with four straight sides free of notches (claims 26-27) or its usage with Applicant's claimed sticker.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1774

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's disclosure does not define what a substantially constant thickness or physical strength is. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 11, 15, 17 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,782,494 to Crandall et al.

Crandall teaches a sticker comprising a sheet material having two opposite major surfaces (Crandall, 30, Fig. 3c); and first (31, Fig. 3c) and second (33, Fig. 3c) adhesive regions both disposed on one of said major surfaces; wherein the other of said major surfaces is free of adhesive material (see space between 31 and 33 of Fig. 3c); the first adhesive region being

disposed adjacent an edge of said sheet material; the second adhesive region being spaced from the first adhesive region and an opposite edge of said sheet material by first (see space between 31 and 33 of Fig. 3c) and second areas of said major surface of said sheet material, respectively, at least said second area being free of adhesive material (see space between 33 extending down to lower edge of 30); wherein a width of said second area, as measured in a direction from the edge adjacent to the first adhesive region to the opposite edge, is larger than a width of said second adhesion region (see Fig. 3c, 33 vs. 33 extending downward to lower edge of 30), wherein said first and second adhesive regions include adhesive that releasably adhere to a material of the other major surface so that said sticker can be peeled off a stack of multiple stickers identical to said sticker (a note pad of POST-IT brand notes is synonymous to stickers peeled off a stack of multiple identical to said sticker) and wherein said sheet material is free of weakened regions (see Crandall, Fig. 3c and col. 2, lines 23-35).

Regarding claim 11, the sheet material is rectangular (see Fig. 3c) having parallel strips as shown.

Regarding claim 15, the opposite edge of the sheet material is free of adhesive material (see region 33 extending downward, Fig. 3c).

Regarding claim 17, the first adhesive 31 extends up to the adjacent edge of the sheet material (31, Fig. 3c).

Regarding claim 25, the sheet material extends continuously throughout the entirety thereof without disruption and apparent tear lines or fold lines (see Fig. 3c).

The claims are anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 12-13, 16, 18-24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable by USPN 5,782,494 to Crandall et al.

Crandall is relied upon above. As stated above, Crandall already teaches most of the structure of instant claims 18 and 22.

Further regarding instant claims 8, 10, 12, 18, and 22, Crandall does not explicitly state the width of the second area is at least 15 mm (claim 8), or the width of the first area is smaller than the width of the second area or second area is 1/5th of a width of a sheet material, or a third adhesive region being disposed inside of the first area, said third adhesive region being spaced from the first and second regions on the same surface (claims 9, 16, and 22).

However, Crandall teaches including several stripes of adhesive parallel to each other (col. 2, line 43), implying more than two stripes, which would make it obvious to one having ordinary skill in the art to adjust the width of the adhesive and adhesive free areas and to include a third adhesive region spaced from the first and second regions within the first area because Crandall teaches including several stripes of adhesive parallel to each other for design purposes (Crandall, col. 2, lines 40-43). Further, changes in widths are merely optimizable as it has been held that discovering an optimum value of a result effective variable involves only routine skill

in the art. *In re Boesch*, 617 F.2d 272. The width effects the coverage area and thereby the overall releasability of the sheet and how the sheet is separated for use.

Regarding claims 13 and 19, the first area is free of adhesive (space between 31 and 33, Fig. 3c).

Regarding claims 20 and 23, the opposite edge is free of adhesive (see region 33 extending downward, Fig. 3c).

Regarding claims 21 and 24, the first adhesive 31 extends up to the adjacent edge of the sheet material (31, Fig. 3c).

Further regarding claims 26-27, the shape is a true rectangle with four straight sides free of notches (see Fig. 3c).

Further regarding claims 18 and 22, physical strength is inherent and the sheet material includes the same materials and is thus equivalent to having substantially constant thickness.

Claims 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable by USPN 5,989,667 to Tayebi.

Tayebi provides a postable sticker having two sides which is surfaced on one side (other of said major surface is free of adhesive material) with releaseable adhesive (such as pressure sensitive or temporary adhesive coatings), allowing for easily releaseable separation from the surfaces to which it is attached. The postable stickers are in stacks. See col. 3, lines 20-26 and 50-55. In Figure 5D, Tayebi shows an adhesive design in this order from top to bottom: a first adhesive adjacent an edge (toward the top) (8), a first area free of adhesive (9), a second adhesive (towards the middle) (8) and a second area free of adhesive (at the bottom) (9) on the surface of a sheet. The adhesives are rectangular and extend parallel to the opposite and adjacent

Art Unit: 1774

edges of the sheet as required by instant claims 11 and 24. See also col. 3, lines 1-25, lines 49-68, and col. 4, lines 1-6 and lines 43-48. Tayebi also provides wherein said first and second adhesive regions include adhesives that releasably adhere to a material of another major surface (another surface of sheets), so that said sticker can be peeled off a stack of multiple stickers identical to said sticker as according to instant claim 14. See col. 4, lines 43-48. Also shown in Figure 5D, the opposite edge of the sheet material is free of adhesive as per instant claim 15. To the new limitations substantially parallel surfaces, substantially constant thickness and physical strength, Tayebi teaches (see Figure 5-D). Physical strength is inherent and the sheet material includes the same materials and is thus equivalent to having substantially constant thickness.

The widths measured in direction L wherein a width of said second area, as measured in a direction from the edge adjacent to the first adhesive region to the opposite edge, is not said to be larger than a width of said second adhesive region, as measured in said direction. A width of said first area as measured in said direction, is not said to be smaller than the width of said second area.

However, Tayebi teaches a plurality of adhesive areas (8) (implying more than one area and making it obvious to include a third area) can be the same or different sizes as well as the adhesive free areas (9) size also. This teaching also suggests the length and widths of both adhesive and adhesive free areas can change. Tayebi explains that tear lines 10 are around areas (8) and (9) are spaced to function for use. Thus, changes in widths are merely optimizable. It would have been obvious to one of ordinary skill in the art to modify the length or distance of adhesive or adhesive free areas because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The

width effects the coverage area and thereby the overall releasability of the sheet and how the sheet is separated for use as explained by Tayebi at col. 3, lines 55-68 and col. 4, lines 1-7.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Applicant has amended the claims to include new limitations to the absence of weakened regions, thus Tayebi is removed solely over claims 7 and its dependent claims, however, Crandall is now used to teach these limitations in addition to the new limitations to the rest of the claims. Note, that should Applicant remove the indicated new matter of claim 7, Tayebi will reapply. Also note the references cited on the 892 form.

Applicant alleges support is found in Figs. 3A and 3B of Applicant's disclosure to teach defining a substantially constant thickness, however, the drawings do not state or define a thickness.

Applicant alleges Tayebi fails to disclose the new limitation to the major surfaces substantially parallel with each other and defines a constant thickness because Tayebi teaches weakened tear line (10), score line (12), and micro-perforated lines. Applicant further alleges that apparently at such tear or fold lines, either the thickness of the sticker changes or the surface of the sheet ceases to be parallel. Applicant has not persuasively argued because Tayebi teaches said various lines is outside the point because Tayebi teaches the surfaces being parallel and the thickness being constant (see Fig. 5-D), the same materials and similar illustration and spacing is taught, therefore, the thickness must be constant and surfaces parallel.

Art Unit: 1774

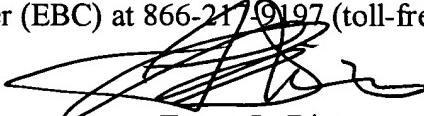
Applicant alleges that a substantially constant physical strength is not taught by Tayebi either because of the tear lines. However, the physical strength is not directly related to Tayebi's teaching of a similar structure and same materials. The Tayebi structure teaches the same releasable adhesives disposed on the same pad of paper, thus the physical strength is inherent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

04/12/05



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U.1774 4/15/05